

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.116, and in light of the remarks which follow, are respectfully requested.

Claims 2-4, 6, 10, 11, 14, and 15 have been canceled without prejudice or disclaimer. Claim 1 has been amended to include subject matter contained in canceled Claims 2 and 3 as well as the draw ratio disclosed at least in Example 5 on page 23 of the present specification. In accordance with MPEP § 714.12, Applicants respectfully submit that the amendment of claim 1 should be entered as it places the present application in condition for allowance or in better form for appeal. *See also* MPEP § 714.12. Claims 1, 5, 7, and 13 are now pending in this application.

Claim Rejection under 35 U.S.C. §102(a)

Claims 1-4, 6, 7, 11, and 13-15 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by EP Patent No. 1264685A ("Nakahara") for the reasons set forth in paragraph (3) of the Office Action. Reconsideration and withdrawal of this rejection are requested for at least the following reasons.

The drawn film defined by amended claim 1 is a single layer film of a layer (A) having a peel area of 50% or more and a thermal coefficient of contraction of 20% or more. Layer (A) comprises a copolymer that is made from 4-methyl-1-pentene and at least one comonomer of ethylene or an α -olefin having 3 to 20 carbon atoms other than 4-methyl-1-pentene. The drawn film is obtained by monoaxial drawing 4.3 times or more.

As noted in MPEP § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Nakahara discloses a multi-layered film comprising a 4-methyl-1-pentene layer on either side of a polypropylene or polyethylene layer. The film has been oriented mono-axially at least twice. Further, Nakahara discloses a single layer film of 4-methyl-1-pentene copolymer (Comparative Example 4 of Nakahara). However, Nakahara teaches neither the peel area nor the thermal coefficient of contraction of the film. Further, as shown in Comparative Example 4 of Nakahara, although the draw ratio was 4 times, 4 films of 5 single layer films of 4-methyl-1-pentene copolymer were broken.

The Examiner asserts, "The film [of Nakahara] is herein understood to have a peel area of 50% or more when the film, together, with a copper foil surface subjected to roughening treatment is subjected to heating and pressing treatment because said laminate is taught [to] exhibit satisfactory releasability from copper foils." (Office Action, Page 3). However, even if a single layer drawn film is prepared according to the process of Nakahara, the drawn film has poor properties compared with the drawn film of the present invention, due to the difference in the processes of Nakahara and the present invention.

In the process of Nakahara, a sheet in which layer (A) is directly stretched to give a drawn film in which layer (A) is an outermost layer (see Figure 1a, *infra*). For example, when a single layer sheet of layer (A) is directly stretched 4 times according to this process (see Figure 1b, *infra*), a resulting drawn film of layer (A) corresponding to Comparative Example 4 of Nakahara has a thermal coefficient of contraction of 15% and a peel area of 20% (see Applicant's Comparative Example 2).

In contrast, the drawn film of the present invention can be produced by the process comprising:

drawing, 4.3 times or more, a sheet comprising layer (A) and layers (B), wherein layers (B) are each formed on each surface of layer (A) as outermost layers; and

peeling layers (B) from layer (A) to give a single layer drawn film of layer (A) (see Figure 2, *infra*). Layer (B) comprises polypropylene and/or polyethylene. As seen in Applicant's Example 1, the single layer drawn film of layer (A) that is produced by drawing and peeling has a thermal coefficient of contraction of 22% and a peel area of 60%.

Thus, compared with the drawn film given by directly stretching, the drawn film of the present invention has excellent properties due to the production process. Further, since Nakahara's process has no peeling step of layer (B) from layer (A), Nakahara fails to teach the process of the present invention, *i.e.*, the production process comprising both a drawing step and a peeling step. Therefore, the drawn film of the present invention cannot be produced based on Nakahara and has distinct characteristics relative to the film of Nakahara.

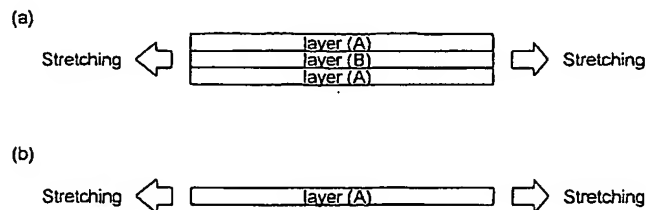


Figure 1 Nakahara's Process

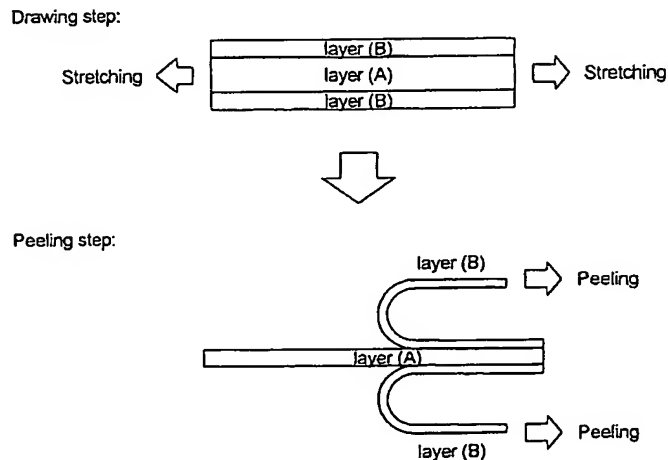


Figure 2 Applicant's Process

In view of the above, the §102 rejection over Nakahara should be reconsidered and withdrawn. Such action is earnestly solicited.

Claim Rejection under 35 U.S.C. §103(a)

Claim 5 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,919,547 ("Kocher") in view of Nakahara for the reasons set forth in paragraph (5) of the Office Action. Reconsideration and withdrawal of this rejection are requested for at least the following reasons.

The process defined by claim 5 comprises drawing, 4.3 times or more, a sheet comprising layer (A) and layer (B) which is formed on layer (A), and peeling layer (B) from layer (A) to give a drawn film comprising layer (A) as at least one outermost layer. The process provides the drawn film having good releasability from a roughened copper foil surface and thermal coefficient of contraction.

Kocher teaches a multilayer film wherein a polyethylene layer is extruded next to a methyl-pentene layer such that said layers peel apart from one another. The multilayer film is used for packages from products such as food products. However, Kocher fails to teach a process for producing a drawn film comprising a drawing step and a peeling step.

As noted in MPEP § 2142, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found

in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that even if there were some suggestion or motivation to combine Kocher and Nakahara, and a reasonable expectation of success (which Applicants do not concede exists), Kocher in view of Nakahara does teach or suggest all the claim limitations. In particular, as described above: (1) Kocher teaches a multilayer film wherein a polyethylene layer is extruded next to a methyl-pentene layer such that said layers peel apart from one another, rather than teaching a process for producing a drawn film comprising a drawing step and a peeling step; and (2) Nakahara fails to teach a production process comprising both a drawing step and a peeling step. Thus, Kocker in view of Nakahara does not teach a process for producing a drawn film comprising a drawing step and a peeling step.

In view of the above, the §103 rejection over Kocher in view of Nakahara should be reconsidered and withdrawn. Such action is earnestly solicited.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

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